

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
William D. Quigg

Application No.: 09/849,504

Confirmation No.: 8692

Filed: May 4, 2001

Art Unit: 3688

For: SYSTEM AND METHOD FOR  
COORDINATING PRODUCTION AND  
DISTRIBUTION OF PAPER PRODUCTS  
PACKAGED WITH PROMOTIONAL  
MATERIALS

Examiner: D. Lastra

**APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on June 3, 2009, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments

- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- Appendix A Claims
- Appendix B Evidence
- Appendix C Related Proceedings

## TABLE OF CONTENTS

I.	<u>REAL PARTY IN INTEREST</u>	5
II.	<u>RELATED APPEALS AND INTERFERENCES</u>	5
III.	<u>STATUS OF CLAIMS</u>	5
IV.	<u>STATUS OF AMENDMENTS</u>	5
V.	<u>SUMMARY OF CLAIMED SUBJECT MATTER</u>	6
A.	<u>Claim 1</u>	6
B.	<u>Claim 11</u>	7
C.	<u>Claim 18</u>	8
D.	<u>Claim 22</u>	9
E.	<u>Claim 26</u>	10
F.	<u>Claim 31</u>	10
G.	<u>Claim 34</u>	11
H.	<u>Claim 49</u>	12
I.	<u>Claim 52</u>	13
J.	<u>Claim 57</u>	13
K.	<u>Claim 61</u>	14
VI.	<u>GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL</u>	14
A.	<u>First Ground of Rejection: Rejections under 35 U.S.C. § 101</u>	14
B.	<u>Second Ground of Rejection: Rejections under 35 U.S.C. § 103(a)</u>	15
VII.	<u>ARGUMENT</u>	15
A.	<u>Rejections under 35 U.S.C. § 101</u>	15
B.	<u>Rejections under 35 U.S.C. § 103(a)</u>	16
1.	<u>Legal Requirements for Obviousness</u>	16
2.	<u>Cited References</u>	18
3.	<u>The rejection of claims 1-7, 9, 11, 14, 16, 18, 20-32, 34-40, 42, 44-47, 49-54, 56, 61-63, and 65-67 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi is improper</u>	20
4.	<u>The rejection of claims 8, 43, and 57-59 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Itkonen is improper</u>	32
5.	<u>The rejection of claims 10, 33, 41, 55, and 64 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Crossman is improper</u>	35
6.	<u>The rejection of claims 12-13, 15, 17, 19, and 50 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb is improper</u>	37
7.	<u>The rejection of claim 60 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, Itkonen, and Crossman is improper</u>	41
8.	<u>Previously-filed Declaration of Commercial Success Demonstrates Non-Obviousness of Claimed Invention</u>	41
VIII.	<u>CONCLUSION</u>	43
IX.	<u>CLAIMS</u>	44
APPENDIX A		45
APPENDIX B		61

APPENDIX C .....	62
------------------	----

I. REAL PARTY IN INTEREST

The rights of the inventor in this application were assigned to Grays Harbor Paper, L.P., of Hoquiam, Washington, as recorded at reel 011789, frame 0988. Grays Harbor Paper, L.P. is the real party in interest for this appeal.

II. RELATED APPEALS AND INTERFERENCES

Neither appellant, appellant's legal representative, nor the above-identified assignee is aware of any other prior or pending appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

III. STATUS OF CLAIMS

Claims 1-67 have been presented. Claim 48 has been canceled. Claims 1-47 and 49-67 are therefore presently pending. Claims 1-47 and 49-67 have been twice rejected.

Claims 1-47 and 49-67 are the subject of the present appeal. The text of these claims is set forth below in the Claims Appendix.

IV. STATUS OF AMENDMENTS

On July 31, 2009, appellant filed an amendment pursuant to 37 C.F.R. § 41.33 amending claims 11 and 34 to recite that the method steps are performed by a computer system and that "computer-executable instructions implementing the method is stored in memory of the computer system for execution by a processor of the computer system," and further amending claim 49 to recite that "computer-executable instructions implementing the receiving of the order from the purchaser and the receiving of the order from the third-party advertiser are stored in memory of a

computing system for execution by a processor of the computing system." This amendment is included in the text of claims 1-47 and 49-67 as set forth below in the Claims Appendix.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Each independent claim being appealed is paraphrased below, with citations to the corresponding portions of the specification and drawings as required by 37 C.F.R. § 41.37(c)(1)(v). These citations are provided in order to illustrate specific examples and embodiments of the recited claim language, and are not intended to limit the claims.

A. Claim 1

Claim 1 is directed to a computer system for processing a paper product (see, e.g., Published U.S. Application No. 2002-0004732 ¶ [0021]; Figure 1 ## 100, 102). The computer system comprises a processor and a memory including instructions together providing, a product order tracker configured to receive a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer, the paper product including a roll of paper or a plurality of unbound, stacked paper sheets (see, e.g., *id.* ¶¶ [0021]-[0022], [0024]-[0025], [0027], [0029], [0042]; Figure 1 ## 102, 108, 159, 160; Figure 2 ## 202, 204, 212; Figure 3 ## 212, 300; Figure 4B # 300; Figure 7 # 706); a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time (see, e.g., *id.* ¶¶ [0027], [0029], [0036]-[0038], [0042], [0045]-[0046]; Figure 2 # 214; Figure 3 ## 214, 302; Figure 4A # 302; Figure 5 ## 180, 182; Figure 6C ## 182, 612; Figure 7 # 708); and a paper product

tracker configured to provide instructions for creating the enclosure for the paper product, the enclosure having the promotional material of the received promotional material order, the paper product tracker further being configured to provide instructions to enclose the paper product of the received order with the created enclosure, wherein the paper manufacturer, the paper purchaser, and the third-party advertiser are different entities and the third-party advertiser pays to have the promotional material placed on the enclosure of the paper product (see, e.g., *id.* ¶¶ [0043]-[0044]; Figure 2 # 216; Figure 3 # 304, 306; Figure 4C # 304; Figure 4D #306; Figure 5 ## 180, 182; Figure 6C ## 182, 612; Figure 7, # 710).

#### B. Claim 11

Claim 11 is directed to a method in a computer system for preparing a paper product (see, e.g., Published U.S. Application No. 2002-0004732 ¶ [0021]; Figure 1 # 100). The method comprises receiving a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer (see, e.g., *id.* ¶¶ [0021]-[0022], [0027], [0029], [0042]; Figure 1 ## 102, 108; Figure 2 # 212; Figure 3 ## 212, 300; Figure 4B # 300; Figure 7 # 706); receiving a promotions order from a third-party advertiser to place promotional material on an enclosure of a paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time (see, e.g., *id.* ¶¶ [0027], [0029], [0036]-[0038], [0042], [0045]-[0046]; Figure 2 # 214; Figure 3 ## 214, 302; Figure 4A # 302; Figure 5 ## 180, 182; Figure 7 # 708); providing instructions to create an enclosure for the paper product, the enclosure having the promotional material of the received promotions order, and providing instructions to enclose the paper product of the received order with the created enclosure (see, e.g., *id.* ¶¶ [0043]; Figure 3 ## 304, 306; Figure 4C # 304; Figure 4D # 306; Figure 5 # 180, 182; Figure 7, # 710); and providing instructions to deliver the paper product enclosed

with the created enclosure to a delivery location, wherein the paper manufacturer, the paper purchaser, and the third-party advertiser are different entities and the third-party advertiser pays to have the promotional material placed on the enclosure of the paper product (see, e.g., *id.* ¶¶ [0027], [0043]-[0044]; Figure 2 # 216; Figure 3 # 308; Figure 4D # 308; Figure 7, # 718). Computer-executable instructions implementing the method are stored in memory of the computer system for execution by a processor of the computer system (see, e.g., *id.* ¶¶ [0021]-[0022]; Figure 1, ## 102, 108; Figure 2 ## 202, 204).

### C. Claim 18

Claim 18 is directed to a computer system for tracking a transaction among a paper manufacturer, a paper purchaser, and a third-party advertiser (see, e.g., Published U.S. Application No. 2002-0004732 ¶ [0021]; Figure 1 ## 100, 102). The computer system comprises a processor and a memory together providing, a paper order tracker configured to track an order from the paper purchaser for purchase of a plurality of unbound, stacked paper sheets produced by the paper manufacturer (see, e.g., *id.* ¶¶ [0021]-[0022], [0024]-[0025], [0027], [0029], [0042]; Figure 1 ## 102, 108, 160; Figure 2 ## 202, 204, 212; Figure 3 ## 212, 300; Figure 4B # 300; Figure 7 # 706); an advertisement order tracker configured to track an order from the third-party advertiser for an advertisement placed on a wrapper configured to at least partially enclose and protect the plurality of unbound, stacked paper sheets, wherein the advertisement is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time (see, e.g., *id.* ¶¶ [0027], [0029], [0036]-[0038], [0042], [0045]-[0046]; Figure 2 # 214; Figure 3 ## 214, 302; Figure 4A # 302; Figure 5 ## 180, 182; Figure 7 # 708); a first remuneration tracker configured to track payment of a first remuneration from the paper purchaser for purchase of the paper (see, e.g., *id.* ¶ [0035]; Figure 2 # 220; Figure 3 ## 220, 310;

Figure 4E ## 310, 432); and a second remuneration tracker configured to track payment of a second remuneration from the third-party advertiser for the advertisement (see, e.g., *id.* ¶ [0035]; Figure 2 # 218; Figure 3 ## 218, 310; Figure 4E ## 310, 436).

D. Claim 22

Claim 22 is directed to a computer system for tracking a transaction among a paper product manufacturer, a paper product purchaser, and a third-party advertiser (see, e.g., Published U.S. Application No. 2002-0004732 ¶ [0021]; Figure 1, ## 100, 102). The computer system comprises a processor and a memory together providing, an order tracker capable of tracking an order from the third-party advertiser for promotional material placed on an enclosure configured to at least partially enclose and protect a paper product, the paper product including a plurality of unbound, stacked paper sheets produced by the paper product manufacturer or a roll of paper produced by the paper product manufacturer, the enclosure including a wrap or a carton configured to at least partially surround the paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper product purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time (see, e.g., *id.* ¶¶ [0027], [0024]-[0025], [0029], [0036]-[0038], [0042], [0045]-[0046]; Figure 1 ## 159, 160; Figure 2 # 202, 204, 214; Figure 3 ## 214, 302; Figure 4A # 302; Figure 5 ## 180, 182; Figure 6A # 182, 600; Figure 6C ## 182, 612; Figure 7 # 708); and a remuneration tracker capable of tracking remuneration paid by the third-party advertiser for the promotional material and updating a database to indicate receipt of the remuneration (see, e.g., *id.* ¶ [0035]; Figure 2 # 218; Figure 3 ## 218, 310; Figure 4E ## 310, 436, 438).

E. Claim 26

Claim 26 is directed to a computer-readable storage medium comprising instructions that, when executed by a processor, cause the processor to perform a method for tracking a transaction among a paper product manufacturer, a paper product purchaser, and a third-party advertiser (see, e.g., Published U.S. Application No. 2002-0004732 ¶¶ [0021]-[0022]; Figure 1, ## 102, 108; Figure 2 ## 202, 204, 210). The method comprises receiving an indication of an order from the third-party advertiser for promotional material placed on an enclosure configured to at least partially enclose and protect a paper product, the paper product including a plurality of unbound, stacked paper sheets produced by the paper product manufacturer, or a roll of paper produced by the paper product manufacturer, the enclosure including a wrap or a carton configured to at least partially surround the paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper product purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser (see, e.g., *id.* ¶¶ [0024]-[0025], [0027], [0029], [0036]-[0038], [0042], [0045]-[0046]; Figure 1 ## 159, 160; Figure 2 # 214; Figure 3 ## 214, 302; Figure 4A # 302; Figure 5 ## 180, 182; Figure 6A # 182, 600; Figure 6C ## 182, 612; Figure 7 # 708); updating a database to indicate receipt of the order (see, e.g., *id.* ¶ [0031]; Figure 4A # 402); receiving an indication that remuneration has been paid by the third-party advertiser for the promotional material (see, e.g., *id.* ¶ [0035]; Figure 2 # 218; Figure 3 ## 218, 310; Figure 4E ## 310, 436); and updating the database to indicate payment of the remuneration (see, e.g., *id.* ¶ [0035]; Figure 2 # 218; Figure 3 ## 218, 310; Figure 4E ## 310, 436, 438).

F. Claim 31

Claim 31 is directed to a method for selling paper products over a computer network (see, e.g., Published U.S. Application No. 2002-0004732 ¶¶ [0021], [0049]-[0051]; Figure 1 ## 100, 102; Figure 8 # 806). The method comprises receiving an order for a paper product from a purchaser over a computer network, the paper product

including unbound stacked sheets of paper or a roll of paper (see, e.g., *id.* ¶¶ [0021]-[0022], [0024]-[0025], [0027], [0029], [0042]; Figure 1 ## 102, 108, 159, 160; Figure 2 ## 202, 204, 206, 212; Figure 3 ## 212, 300; Figure 4B # 300; Figure 7 # 706; Figure 8 ## 802, 804, 808); and filling the order with a paper product manufactured by a paper product manufacturer, the paper product being at least partially enclosed by a protective enclosure, the enclosure having promotional material configured to identify and/or promote goods and/or services of a third party different from the manufacturer and different from the purchaser, wherein an identity of the purchaser is withheld from the paper product manufacturer and an identity of the paper product manufacturer is withheld from the purchaser, wherein the promotional material is specifically targeted to a group of people associated with the purchaser, the group comprising those people likely to purchase the goods or services of the third-party (see, e.g., *id.* ¶¶ [0036]-[0038], [0042]-[0046], [0052]; Figure 5 ## 180, 182; Figure 6C ## 182, 612; Figure 7 # 710; Figure 8 ## 808, 812, 814).

#### G. Claim 34

Claim 34 is directed to a method in computer systems for providing paper products with promotional materials (see, e.g., Published U.S. Application No. 2002-0004732 ¶ [0021]; Figure 1 ## 100, 102). The method comprises receiving an order from a purchaser for a paper product, the paper product including unbound stacked sheets of paper or a roll of paper (see, e.g., *id.* ¶¶ [0021]-[0022], [0024]-[0025], [0027], [0029], [0042]; Figure 1 ## 102, 108, 159, 160; Figure 2 # 212; Figure 3 ## 212, 300; Figure 4B # 300; Figure 7 # 706); providing instructions for manufacturing the paper product (see, e.g., *id.* ¶ [0043]; Figure 7 ## 706, 712); providing instructions for disposing promotional material on an enclosure configured to at least partially enclose and protect the paper product, the promotional material being requested by a third-party advertiser different than the purchaser, wherein the promotional material is specifically targeted to a group of people associated with the purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser (see, e.g.,

*id.* ¶¶ [0036]-[0038], [0042]-[0046]; Figure 5 ## 180, 182; Figure 6C ## 182, 612; Figure 7 # 710); and providing instructions for disposing the paper product within the enclosure (see, e.g., *id.* ¶ [0043]; Figure 3 #306; Figure 4D #306; Figure 7 ## 714, 716). Computer-executable instructions implementing the method are stored in memory of the computer systems for execution by one or more processors of the computer systems (see, e.g., *id.* ¶¶ [0021]-[0022]; Figure 1 ## 102, 108; Figure 2 ## 202, 204).

#### H. Claim 49

Claim 49 is directed to a method for providing paper products with promotional materials (see, e.g., Published U.S. Application No. 2002-0004732 ¶ [0021]; Figure 1 # 100). The method comprises receiving an order from a purchaser for a ream of paper (see, e.g., *id.* ¶¶ [0021]-[0022], [0027], [0029], [0042]; Figure 1 ## 102, 108, 112; Figure 2 # 212; Figure 3 ## 212, 300; Figure 4B # 300; Figure 7 # 706); receiving an order from a third-party advertiser for an advertisement placed on a wrapper configured to at least partially enclose and protect the ream of paper, wherein the promotional material is specifically targeted to a group of people associated with the purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser (see, e.g., *id.* ¶¶ [0027], [0029], [0036]-[0038], [0042], [0045]-[0046]; Figure 2 # 214; Figure 3 ## 214, 302; Figure 4A # 302; Figure 5 ## 180, 182; Figure 7 # 708); manufacturing the ream of paper (see, e.g., *id.* ¶ [0043]; Figure 7 # 712); wrapping the ream of paper with the wrapper, the wrapper having the advertisement and at least partially enclosing and protecting the ream of paper (see, e.g., *id.* ¶ [0043]; Figure 5 ## 180, 182; Figure 7 ## 714, 716); receiving a first remuneration from the purchaser for the ream of paper (see, e.g., *id.* ¶ [0035]; Figure 2 # 220; Figure 3 ## 220, 310; Figure 4E ## 310, 432); and receiving a second remuneration from the third-party advertiser for the advertisement on the wrapper (see, e.g., *id.* ¶ [0035]; Figure 2 # 218; Figure 3 ## 218, 310; Figure 4E ## 310, 436). Computer-executable instructions implementing the receiving of the order from the purchaser and the receiving of the order from the third-party advertiser are stored in memory of a computing system for execution by a

processor of the computing system (see, e.g., *id.* ¶¶ [0021]-[0022]; Figure 1, ## 102, 108; Figure 2 ## 202, 204).

I. Claim 52

Claim 52 is directed to a package of paper products (see, e.g., Published U.S. Application No. 2002-0004732 ¶¶ [0021], [0024]-[0026]; Figure 1, # 181). The package of paper products comprises a plurality of stacked, unbound paper sheets produced by a paper sheet manufacturer and purchased by a paper purchaser (see, e.g., *id.* ¶¶ [0024]-[0025]; Figure 1 ## 160, 181); a wrapper disposed around the plurality of paper sheets, the wrapper being positioned to at least partially enclose and protect the plurality of paper sheets (see, e.g., *id.* ¶¶ [0036]-[0038]; Figure 5 # 180); and promotional material disposed on the wrapper, the promotional material having a content configured to identify and/or promote goods and/or services of a paying third-party advertiser different from the manufacturer and different from the paper purchaser, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser (see, e.g., *id.* ¶¶ [0036]-[0038], [0044]; Figure 5, ## 180, 182).

J. Claim 57

Claim 57 is directed to a packaged roll of paper (see, e.g., Published U.S. Application No. 2002-0004732 ¶¶ [0021], [0024]-[0026]; Figure 1 # 185). The packaged roll of paper comprises an elongated sheet of paper rolled upon itself to form a paper roll, the elongated sheet of paper being produced by a paper sheet manufacturer and purchased by a paper purchaser (see, e.g., *id.* ¶¶ [0025]-[0024]; Figure 1 ## 159, 185); a wrapper disposed around the paper roll, the wrapper being positioned to at least partially enclose and protect the paper roll (see, e.g., *id.* ¶¶ [0036]-[0040]; Figure 6C # 612); and promotional material disposed on the wrapper, the promotional material

having a content configured to identify and/or promote goods and/or services of a paying third-party advertiser different from the manufacturer and different from the paper purchaser, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser (see, e.g., *id.* ¶¶ [0036]-[0040], [0044]; Figure 6C ## 182, 612).

#### K. Claim 61

Claim 61 is directed to a package of paper products (see, e.g., Published U.S. Application No. 2002-0004732 ¶¶ [0021], [0024]-[0026]; Figure 1, # 181). The package of paper products comprises a plurality of unbound paper sheets produced by a paper sheet manufacturer and purchased by a paper purchaser (see, e.g., *id.* ¶¶ [0024]-[0025]; Figure 1 ## 160, 181); a carton in which the plurality of paper sheets is positioned, the carton at least partially enclosing and protecting the paper sheets (see, e.g., *id.* ¶¶ [0036]-[0038]; Figure 6A # 600); and promotional material disposed on the carton, the promotional material having a content configured to identify and/or promote goods and/or services of a paying third-party advertiser different from the paper sheet manufacturer and the paper purchaser, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time (see, e.g., *id.* ¶¶ [0036]-[0038], [0044]-[0045]; Figure 6A ## 600, 182).

### VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

#### A. First Ground of Rejection: Rejections under 35 U.S.C. § 101

The Examiner rejected claims 11, 34, and 49 under 35 U.S.C. § 101.

B. Second Ground of Rejection: Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-7, 9, 11, 14, 16, 18, 20-32, 34-40, 42, 44-47, 49-54, 56, 61-63, and 65-67 under 35 U.S.C. § 103(a) over a combination of U.S. Patent No. 6,173,274 ("Ryan") and International Patent Publication No. WO 96/29263 ("Giacomozzi").

The Examiner rejected claims 8, 43, and 57-59 under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and U.S. Patent No. 5,473,863 ("Itkonen").

The Examiner rejected claims 10, 33, 41, 55, and 64 under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and U.S. Patent No. 5,035,515 ("Crossman").

The Examiner rejected claims 12-13, 15, 17, 19, and 50 under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, and U.S. Patent No. 6,421,652 ("Loeb").

The Examiner rejected claim 60 under 35 U.S.C. § 103(a) over a combination of Ryan, Giacomozzi, Itkonen, and Crossman.

VII. ARGUMENT

A. Rejections under 35 U.S.C. § 101

The Examiner rejected claims 11, 34, and 49 under 35 U.S.C. § 101 as being directed to non-statutory subject matter (Office Action, December 3, 2008, p. 2). In particular, the Examiner states

Claims 11, 34 and 49 are rejected under 35 U.S.C. 101 because . . . a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) . . . or (2) transform underlying subject matter (such as an article or materials) to a different state or thing . . . Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus).

(*id*; emphasis added). Although the Examiner refers to the machine-or-transformation test recently set forth by the Federal Circuit in *In re Bilski*, 545 F.3d 943, 959-960 (Fed. Cir. 2008), the Examiner does not address the transformation prong of the machine-or-transformation test. Appellant submits that each of claims 11, 34, and 49 satisfies Bilski's transformation prong in that each claim transforms an enclosure of a paper product to include an advertisement or promotional material. Moreover, as amended, appellant submits that each of claims 11, 34, and 49 satisfies that machine prong of the machine-or-transformation test in that all or a portion of the method steps recited by claims 11, 34, and 49 are performed by one or more computer systems.<sup>1</sup> Accordingly, appellant submits that these claims are directed to patentable subject matter and requests that the rejection of claims 11, 34, and 49 under 35 U.S.C. § 101 be reversed.

B. Rejections under 35 U.S.C. § 103(a)

1. Legal Requirements for Obviousness

The Examiner has rejected claims 1-47 and 49-67 as being obvious under 35 U.S.C. § 103(a), which provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The Supreme Court has provided the following guidance in applying Section 103. In *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), the Court stated:

---

<sup>1</sup> In an Amendment file on July 31, 2009, appellant amended claims 11 and 34 to recite that the method steps are performed by a computer system and that "computer-executable instructions implementing the method is stored in memory of the computer system for execution by a processor of the computer system", and amended claim 49 to recite that "computer-executable instructions implementing the receiving of the order from the purchaser and the receiving of the order from the third-party advertiser are stored in memory of a computing system for execution by a processor of the computing system."

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

More recently, the Supreme Court reaffirmed the holdings of *Graham* and clarified several aspects of the manner in which obviousness should be determined (*KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007)). First, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," but "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious" (*id.* at 1739-40). Second, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"; rather, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" (*id.* at 1741). The Court recognized that many significant advances will combine familiar elements: "inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known" (*id.*).

Following the decision in *KSR Int'l*, the United States Patent and Trademark Office ("USPTO") issued a memorandum to all Examiners. The memorandum directs Examiners to continue to determine why a person of ordinary skill in the art would make the combination: "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed" (USPTO Memorandum, *Supreme Court decision on KSR Int'l. Co. v. Teleflex, Inc.*, May 3, 2007, p. 2).

As discussed below in Sections VII(B)(3)-(8), under the Graham standards as applied by KSR, appellant's invention would not have been obvious. The Examiner has not identified prior art references, or a combination thereof, that discloses all the elements of claims 1-47 and 49-67. Therefore, the rejection of these claims should be reversed.

2. Cited References

a. Ryan

Ryan describes a production mail system for printing messages, such as advertisements, on envelopes addressed to a single, specific recipient (Ryan 5:10-40). During operation, the sender submits a mailing list to the data processing system for processing (*id.* 11:28-30). The mailing list includes multiple recipient addresses to which the sender wishes to send mail pieces (*id.* 11:30-32). The data processing system reviews the mailing list and determines which recipients should have advertisements printed on their envelopes (*id.* 11:41-46). The data processing system also selects advertisements for each specific recipient based on the advertiser's restriction data, the recipient's address, and the demographic information in an address demographics database (*id.* 11:61-67). As a result, one or more specific advertisements are printed on each envelope, and are sent to the single recipient of the envelope (*id.* 12:28-29).

b. Giacomozzi

Giacomozzi describes paper handkerchief wrappers that have advertisements printed on the outside of the wrappers (Giacomozzi p. 1). The advertisements are not linked to the handkerchiefs and Giacomozzi's method does not exercise any control over who will see each advertisement. In particular, the advertisements are not targeted to any specific person or group of people.

c. Itkonen

Itkonen describes a technique for evenly tightening a wrapper around a paper roll to produce a smooth and durable roll package (Itkonen 2:52-53, 3:4). Itkonen mentions that "[r]oll wrappers are often printed with factory logos, thus acting as factory 'visiting cards'" (*id.* 1:64-67). According to Itkonen, it is important to remove the crease in roll wrappers because, "[a] creased roll wrapper looks ugly and thereby acts as bad advertising for the product and factory image" (*id.*).

d. Crossman

Crossman describes a package, such as a retail shopping bag, that has a detachable coupon compartment (Crossman 1:5-9, 4:10-13). Crossman makes clear that "[w]hen the coupon compartment is detached, the packaging is still functional" (*id.*). Crossman discredits techniques that print promotional messages directly onto the packaging because "[c]oupons printed directly onto packaging...are not easily removed and if they are removed, the packaging is damaged" (*id.* 1:10:22).

e. Loeb

Loeb describes a technique for providing a consumer with free subscriptions to trade publications based on the consumer's answers to a universal questionnaire (Loeb 2:40-42). According to Loeb, "consumer magazine publishers pursue consumers and subscriptions in very different ways from trade publication publishers. For instance, in the consumer environment, 60% of all new subscriptions are acquired by third-party service providers known as agents" (*id.* 2:9-16). Loeb suggests that "[a]gents enjoy a superior economic model because they acquire subscriptions for dozens of magazines simultaneously. Thus, agents can pass on acquisition costs to multiple publishers" (*id.*). According to Loeb, "[t]he agency model has no parallel in the trade publication universe" (*id.* 2:16-18).

3. The rejection of claims 1-7, 9, 11, 14, 16, 18, 20-32, 34-40, 42, 44-47, 49-54, 56, 61-63, and 65-67 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi is improper

a. Claims 1-7, 9, 66-67

- i. The cited references do not disclose or suggest "wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser"

Ryan describes a production mail system for printing messages, such as advertisements, on envelopes addressed to a single, specific recipient (Ryan 5:10-40). For example, Ryan's mail system may be used to print advertisements on the envelopes of credit card statements for customers of a credit card company (*id.*). During operation, a sender (e.g., credit card company) submits a mailing list to the data processing system for processing (*id.* 11:28-30). The data processing system reviews the mailing list and selects advertisement that are printed on each envelope (*id.* 11:41-67, 12:28-29).

The Examiner asserts that column 10, lines 15-50 of Ryan discloses "wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser," as recited by claim 1 (Office Action, December 3, 2008, p. 4). Specifically, in the section of Ryan cited by the Examiner, Ryan states that an advertiser may indicate geographic areas the advertiser wants to target (*id.* 10:15-50). As a result, certain advertisements will be selected only for recipients having an address in the targeted geographic area. Appellant submits that the individual advertising targeting disclosed in Ryan is fundamentally different than the group advertising targeting claimed by appellant. It is incorrect to say that the advertisements on envelopes addressed to multiple individuals on a sender's mailing list, whether

filtered by geography or other factor, are the same as advertisements on one of appellant's paper products (be it a roll of paper or a stack of unbound paper sheets) that are targeted to a group. Ryan makes clear that each individual envelope is addressed to a single recipient, and the advertisements placed on each envelope target only that single recipient (*id.* 5:38-40, 13:32-34). The selection of a geographic area does not define a group, but merely acts as a filter to aid in individual targeting. Ryan, however, fails to disclose or suggest placing promotional material on an enclosure for a paper product that is "specifically targeted to a group of people associated with the paper purchaser" as recited by independent claim 1.

The Examiner asserts that appellant is arguing about an element not stated in the claims (Office Action, December 3, 2008, pp. 13-14). The Examiner is incorrect. Independent claim 1 recites "a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time" (emphasis added). There is nothing in Ryan that discloses or suggest that advertisements on individual mailpieces are "targeted to a group of people associated with the paper purchaser" as recited.

Appellant further submits that Giacomozi fails to cure the deficiencies of Ryan. Giacomozi does not target advertisements at all, but rather assumes that anyone in the general public might view the handkerchief wrappers. For example, Giacomozi suggests that its handkerchief wrapper "represents a possible publicity vehicle with large diffusion" because the wrapper "is pulled out and shown, by the user, to the public each time a handkerchief is taken" (Giacomozi p. 1). Appellant submits that it is impossible to target a group of individuals by virtue of the random nature of the use of a wrapped hankerchief. Since both Ryan and Giacomozi are missing elements of

appellant's independent claim 1, appellant submits that claims 1-7, 9, and 66-67 are patentable over the combination of Ryan and Giacomozi. For at least this reason, appellant requests that the rejection of claims 1-7, 9, and 66-67 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozi be reversed.

- ii. The cited references do not disclose or suggest that "the group of people are likely to view the promotional material on the enclosure for an extended period of time"

The Examiner asserts that column 10, lines 15-50 of Ryan discloses "wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time," as recited by claim 1 (Office Action, December 3, 2008, p. 4).<sup>2</sup> The Examiner is mistaken. As discussed above in Section VII(B)(3)(a)(i), in the section of Ryan cited by the Examiner, Ryan states that an advertiser may indicate geographic areas the advertiser wants to target. There is nothing in the cited section of Ryan, or any other section, to suggest that a recipient of a mailpiece produced by Ryan's system is "likely to view the promotional material on the enclosure for an extended period of time" as recited by claim 1. Appellant's recited enclosure differs significantly from the envelopes and handkerchief wrappers of Ryan and Giacomozi. The differences are evident, for example, with respect to: 1) the delivery means for the product, 2) what happens to the product before use, and 3) who is exposed to the product. An envelope, as in Ryan, typically arrives at a recipient's address, is read and opened by the recipient, and then is quickly discarded. A handkerchief wrapper, as in Giacomozi, typically sits on a store shelf where it is exposed to an unknown group of people, is purchased, and then is stored in a purse or a pocket except for brief periods when a

---

<sup>2</sup> Appellant notes that the Examiner further states that "[a]pplicant is arguing about limitation not stated in the claims and not even mentioned in the prior art" (Office Action, December 3, 2008, p. 13; emphasis added). Appellant submits that independent claims 1, 11, 18, 22, and 61 each recite "wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time." Because the Examiner admits that this element is *not even mentioned in the prior art*, appellant submits that independent claims 1, 11, 18, 22, 61, and each of their dependents are patentable over the cited references.

handkerchief is removed, at which time it may again be exposed to an unknown group of people. By contrast, the enclosure recited in claim 1, which encloses a roll of paper or unbound, stacked paper sheets (e.g., on reams of paper), typically sits stacked in an oft-frequented office area (e.g., a copy room) for weeks or months at a time. The people exposed to the enclosure are typically an identifiable audience, e.g., the office employees. Thus, it is possible to place promotional material on such an enclosure that is targeted to a known group of people and that will be exposed to the people for an extended period of time. Neither Ryan nor Giacomozi teach or suggest targeted advertising that is applicable for an extended period. Thus, for at least this additional reason, appellant submits that claims 1-7, 9, and 66-67 are patentable over the combination of Ryan and Giacomozi and requests that the rejection of these claims under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozi be reversed.

iii. Ryan and Giacomozi teach away from their combination

Even assuming for the sake of argument that the combination of Ryan and Giacomozi discloses all of the claimed features, appellant respectfully submits that the references cannot properly be combined because Ryan and Giacomozi teach away from their combination. Ryan teaches away from placing promotional material on Giacomozi's wrappers. Specifically, Ryan teaches away from placing promotional material on items when "the third party advertiser cannot exercise any control over who receives the message" (Ryan 2:65-66). Thus, Ryan teaches away from placing promotional material on Giacomozi's wrappers because the advertiser cannot exercise any control over who receives the message. Rather, the message is received by random individuals who either purchase Giacomozi's handkerchief packages or notice the promotional message on one of Giacomozi's handkerchief packages. This is precisely the type of advertising Ryan's invention is designed to avoid.<sup>3</sup> As the

<sup>3</sup> The Examiner asserts that "if Giacomozi would have mentioned anything that disparage[s] targeted advertisement" then Ryan and Giacomozi would teach away from their combination (Office Action,

Examiner correctly noted previously, Ryan's invention is directed at "resolv[ing] this problem by giving advertisers control over targeting their messages" (Office Action, August 16, 2006, p. 10). Accordingly, the Examiner's suggested use of Ryan's system to print promotional material onto Giacomozi's wrappers contravenes one purpose of Ryan's invention—overcoming the disadvantage of conventional advertising campaigns in which the third party advertiser cannot exercise control over who receives the message (Ryan 2:65-66)—and thus one skilled in the art would not have been motivated to combine Ryan and Giacomozi.

Moreover, appellant submits that one skilled in the art would have no reasonable expectation of success combining Ryan and Giacomozi because a technique for doing so would entail complexities that would require a detailed explanation for one of ordinary skill in the art to implement, which is not present in either Ryan or Giacomozi. For example, the Examiner states:

[I]t would have been obvious to a person of ordinary skill in the art . . . to know that advertisers would place advertisements in the Giacomozi's wrappers if said advertisers would have had control on the type of advertisements that said advertisers would want to advertise and the type of users that said advertisers would want to target (i.e. geographic location, age, income), as taught by Ryan in view that said advertisers are paying for said placing and therefore, would like to have control of said placing.

(Office Action, December 3, 2008, p. 15; emphasis added). The Examiner suggests that one skilled in the art would be motivated to combine Ryan with Giacomozi because *if said advertisers would have had control* they would have like it. Giacomozi system is directed to displaying promotional messages to the public at large. For example, Giacomozi states that "[t]he wrapping containing paper handkerchiefs, in fact, is pulled out and shown, by the user, to the public each time a handkerchief is taken from the same, and this represents a possible publicity vehicle with large

---

December 3, 2008, p. 14). Appellant is not aware of any authority that requires each cited reference to disparage every other cited reference. Ryan already disparages non-targeted advertising techniques,

diffusion" (Giacomozi p. 1). It is unclear, and neither Ryan nor Giacomozi suggest, how one skilled in the art would combine Ryan's system with Giacomozi to predict which user would purchase a particular handkerchief wrapper or to control how that user would publicly display the handkerchief wrapper. Under such circumstances, it is difficult to understand how the advertising on the wrapper could be targeted. Accordingly, appellant submits that one skilled in the art would have no reasonable expectation of success combining Giacomozi with Ryan to achieve the type of control suggested by the Examiner.

For at least the foregoing reasons, appellant submits that claims 1-7, 9, and 66-67 are patentable over the combination of Ryan and Giacomozi and requests that the rejection of these claims under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozi be reversed.

b. Claims 11, 14, and 16

Independent claim 11 recites "receiving a promotions order from a third-party advertiser to place promotional material on an enclosure of a paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time" (emphasis added).

As discussed above in Sections VII(B)(3)(a)(i)-(ii), Ryan and Giacomozi fail to disclose or suggest each of emphasized claim elements. Thus, for similar reasons to those discussed above in Sections VII(B)(3)(a)(i)-(ii), appellant submits that independent claim 11, as well as dependent claims 14 and 16, are patentable over the combination of Ryan and Giacomozi. Moreover, as discussed above in Section

---

such as Giacomozi's, in which "the third party advertiser does not exercise any control over when the

VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozi, as proposed by the Examiner, at least because Ryan and Giacomozi teach away from their combination. Accordingly, appellant requests that the rejection of claims 11, 14, and 16 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozi be reversed.

c. Claims 18 and 20-21

Independent claim 18 recites "a paper order tracker configured to track an order from the paper purchaser for purchase of a plurality of unbound, stacked paper sheets produced by the paper manufacturer" and "an advertisement order tracker configured to track an order from the third-party advertiser for an advertisement placed on a wrapper configured to at least partially enclose and protect the plurality of unbound, stacked paper sheets, wherein the advertisement is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time" (emphasis added).

As discussed above in Sections VII(B)(3)(a)(i)-(ii), Ryan and Giacomozi fail to disclose or suggest each of emphasized claim elements. Thus, for similar reasons to those discussed above in Sections VII(B)(3)(a)(i)-(ii), appellant submits that independent claim 18, as well as dependent claims 20-21, are patentable over the combination of Ryan and Giacomozi. Moreover, as discussed above in Section VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozi, as proposed by the Examiner, at least because Ryan and Giacomozi teach away from their combination. Accordingly, appellant requests that the rejection of claims 18 and 20-21 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozi be reversed.

d. Claims 22-25

Independent claim 22 recites "an order tracker capable of tracking an order from the third-party advertiser for promotional material placed on an enclosure configured to at least partially enclose and protect a paper product, the paper product including a plurality of unbound, stacked paper sheets produced by the paper product manufacturer or a roll of paper produced by the paper product manufacturer, the enclosure including a wrap or a carton configured to at least partially surround the paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper product purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time" (emphasis added).

As discussed above in Sections VII(B)(3)(a)(i)-(ii), Ryan and Giacomozi fail to disclose or suggest each of emphasized claim elements. Thus, for similar reasons to those discussed above in Sections VII(B)(3)(a)(i)-(ii), appellant submits that independent claim 22, as well as dependent claims 23-25, are patentable over the combination of Ryan and Giacomozi. Moreover, as discussed above in Section VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozi, as proposed by the Examiner, at least because Ryan and Giacomozi teach away from their combination. Accordingly, appellant requests that the rejection of claims 22-25 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozi be reversed.

e. Claims 26-30

Independent claim 26 recites "receiving an indication of an order from the third-party advertiser for promotional material placed on an enclosure configured to at least partially enclose and protect a paper product, the paper product including a plurality of unbound, stacked paper sheets produced by the paper product manufacturer, or a roll of paper produced by the paper product manufacturer, the enclosure including a wrap or

a carton configured to at least partially surround the paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper product purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser" (emphasis added).

As discussed above in Section VII(B)(3)(a)(i), Ryan and Giacomozzi fail to disclose or suggest the emphasized claim element. Thus, for similar reasons to those discussed above in Section VII(B)(3)(a)(i), appellant submits that independent claim 26, as well as dependent claims 25-30, are patentable over the combination of Ryan and Giacomozzi. Moreover, as discussed above in Section VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozzi, as proposed by the Examiner, at least because Ryan and Giacomozzi teach away from their combination. Accordingly, appellant requests that the rejection of claims 26-30 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi be reversed.

f. Claims 31-32

Independent claim 31 recites "receiving an order for a paper product from a purchaser over a computer network, the paper product including unbound stacked sheets of paper or a roll of paper" and "filling the order with a paper product manufactured by a paper product manufacturer, the paper product being at least partially enclosed by a protective enclosure, the enclosure having promotional material configured to identify and/or promote goods and/or services of a third party different from the manufacturer and different from the purchaser, wherein an identity of the purchaser is withheld from the paper product manufacturer and an identity of the paper product manufacturer is withheld from the purchaser, wherein the promotional material is specifically targeted to a group of people associated with the purchaser, the group comprising those people likely to purchase the goods or services of the third-party" (emphasis added).

As discussed above in Section VII(B)(3)(a)(i), Ryan and Giacomozzi fail to disclose or suggest the emphasized claim element. Thus, for similar reasons to those discussed above in Section VII(B)(3)(a)(i), appellant submits that independent claim 31 and dependent claim 32 are patentable over the combination of Ryan and Giacomozzi. Moreover, as discussed above in Section VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozzi, as proposed by the Examiner, at least because Ryan and Giacomozzi teach away from their combination. Accordingly, appellant requests that the rejection of claims 31-32 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi be reversed.

g. Claims 34-40, 42, 44-47 and 65

Independent claim 34 recites "receiving an order from a purchaser for a paper product, the paper product including unbound stacked sheets of paper or a roll of paper" and "providing instructions for disposing promotional material on an enclosure configured to at least partially enclose and protect the paper product, the promotional material being requested by a third-party advertiser different than the purchaser, wherein the promotional material is specifically targeted to a group of people associated with the purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser" (emphasis added).

As discussed above in Section VII(B)(3)(a)(i), Ryan and Giacomozzi fail to disclose or suggest the emphasized claim element. Thus, for similar reasons to those discussed above in Section VII(B)(3)(a)(i), appellant submits that independent claim 34, as well as dependent claims 40, 42, 44-47 and 65, are patentable over the combination of Ryan and Giacomozzi. Moreover, as discussed above in Section VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozzi, as proposed by the Examiner, at least because Ryan and Giacomozzi teach away from their combination. Accordingly, appellant requests that the rejection of claims 34-40, 42, 44-47 and 65 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi be reversed.

Moreover, appellant submits that dependent claim 65 is further patentable over Ryan and Giacomozzi. The Examiner asserts that column 10, lines 50-67 disclose "instructing another entity to dispose the promotional material on the enclosure" (Office Action, December 3, 2008, pp. 9, 13). In particular, the Examiner states that "another entity' is allowing 'other advertisers' to restrict ad space" (*id.* p. 13). In the cited section, Ryan explains that advertisers may specify in their profiles whether or not they allow other advertisers' advertisements to occupy ad space on the envelope on which their advertisements are placed. Appellant is confused by the Examiner's conclusion that allowing other advertisers to restrict ad space corresponds to instructing another entity to dispose the promotional material on the enclosure. Nowhere does Ryan disclose or suggest that the operator of its mail system instructs another entity to place an advertisement on an envelope. Accordingly, appellant submits that claim 65 is patentable over the combination of Ryan and Giacomozzi and requests that the rejection of claim 65 under 35 U.S.C. § 103(a) be reversed.

h. Claims 49-51

Independent claim 49 recites "receiving an order from a purchaser for a ream of paper" and "receiving an order from a third-party advertiser for an advertisement placed on a wrapper configured to at least partially enclose and protect the ream of paper, wherein the promotional material is specifically targeted to a group of people associated with the purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser" (emphasis added).

As discussed above in Section VII(B)(3)(a)(i), Ryan and Giacomozzi fail to disclose or suggest the emphasized claim element. Thus, for similar reasons to those discussed above in Section VII(B)(3)(a)(i), appellant submits that independent claim 49, as well as dependent claims 50-51, are patentable over the combination of Ryan and Giacomozzi. Moreover, as discussed above in Section VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozzi, as proposed by the Examiner, at

least because Ryan and Giacomozzi teach away from their combination. Accordingly, appellant requests that the rejection of claims 49-51 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi be reversed.

i. Claims 52-54 and 56

Independent claim 52 recites "a plurality of stacked, unbound paper sheets produced by a paper sheet manufacturer and purchased by a paper purchaser; a wrapper disposed around the plurality of paper sheets, the wrapper being positioned to at least partially enclose and protect the plurality of paper sheets; and promotional material disposed on the wrapper, the promotional material having a content configured to identify and/or promote goods and/or services of a paying third-party advertiser different from the manufacturer and different from the paper purchaser, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser" (emphasis added).

As discussed above in Section VII(B)(3)(a)(i), Ryan and Giacomozzi fail to disclose or suggest the emphasized claim element. Thus, for similar reasons to those discussed above in Section VII(B)(3)(a)(i), appellant submits that independent claim 52, as well as dependent claims 53-54 and 56, are patentable over the combination of Ryan and Giacomozzi. Moreover, as discussed above in Section VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozzi, as proposed by the Examiner, at least because Ryan and Giacomozzi teach away from their combination. Accordingly, appellant requests that the rejection of claims 52-54 and 56 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi be reversed.

j. Claims 61-63

Independent claim 61 recites "a plurality of unbound paper sheets produced by a paper sheet manufacturer and purchased by a paper purchaser; a carton in which the

plurality of paper sheets is positioned, the carton at least partially enclosing and protecting the paper sheets; and promotional material disposed on the carton, the promotional material having a content configured to identify and/or promote goods and/or services of a paying third-party advertiser different from the paper sheet manufacturer and the paper purchaser, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time" (emphasis added).

As discussed above in Sections VII(B)(3)(a)(i)-(ii), Ryan and Giacomozzi fail to disclose or suggest each of emphasized claim elements. Thus, for similar reasons to those discussed above in Sections VII(B)(3)(a)(i)-(ii), appellant submits that independent claim 61, as well as dependent claims 62-63, are patentable over the combination of Ryan and Giacomozzi. Moreover, as discussed above in Section VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozzi, as proposed by the Examiner, at least because Ryan and Giacomozzi teach away from their combination. Accordingly, appellant requests that the rejection of claims 61-63 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi be reversed.

4. The rejection of claims 8, 43, and 57-59 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Itkonen is improper

a. Claim 8

Claim 8 depends from claim 1. Thus, for at least the same reasons discussed above in Section VII(B)(3)(a), appellant requests that the rejection of claim 8 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Itkonen be reversed.

b. Claim 43

Claim 43 depends from claim 34. Thus, for at least the same reasons discussed above in Section VII(B)(3)(g), appellant requests that the rejection of claim 43 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozi, and Itkonen be reversed.

c. Claims 57-59

Independent claim 57 recites "an elongated sheet of paper rolled upon itself to form a paper roll, the elongated sheet of paper being produced by a paper sheet manufacturer and purchased by a paper purchaser; a wrapper disposed around the paper roll, the wrapper being positioned to at least partially enclose and protect the paper roll; and promotional material disposed on the wrapper, the promotional material having a content configured to identify and/or promote goods and/or services of a paying third-party advertiser different from the manufacturer and different from the paper purchaser, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser" (emphasis added).

As discussed above in Section VII(B)(3)(a)(i), Ryan and Giacomozi fail to disclose or suggest the emphasized claim element. Thus, for similar reasons to those discussed above in Section VII(B)(3)(a)(i), appellant submits that independent claim 57, as well as dependent claims 58-59, are patentable over the combination of Ryan and Giacomozi. In addition, as discussed above in Section VII(B)(3)(a)(iii), one skilled in the art would not seek to combine Ryan and Giacomozi, as proposed by the Examiner, at least because Ryan and Giacomozi teach away from their combination.

Moreover, appellant submits that Itkonen does not cure the deficiencies of Ryan and Giacomozi. Itkonen describes a technique for tightening a wrapper containing a factory logo around a paper roll (Itkonen 2:52-53, 3:4). Nowhere does Itkonen disclose

or suggest that the wrapper contains promotional material that is specifically targeted to a group of people associated with the paper purchaser. Further, one skilled in the art would not seek to combine Ryan, Giacomozzi, and Itkonen at least because they teach away from their combination. The Examiner suggests the following as the reason to combine Ryan and Itkonen:

[I]t would have been obvious...to know that the same method used by Ryan to print advertisements in the enclosure of unbound, staked paper sheets (Ryan figure 1, item 17) would be used to print advertisements in Itkonen's roll wrapper of a roll of paper sheets in view that said wrapper would include promotions that would subsidize the cost of producing and wrapping said paper roll, as taught by Ryan.

(Office Action, December 3, 2008, p. 10; emphasis added). Appellant disagrees and submits that Itkonen teaches away from Ryan. Itkonen is directed to manufacturing a roll of paper having the factory's logo on the roll wrapper. In particular, Itkonen explains that "[r]oll wrappers are often printed with factory logos, thus acting as factory 'visiting cards'" (Itkonen 1:64-67; emphasis added). Itkonen further explains that removing the crease in roll wrappers is important because, "[a] creased roll wrapper looks ugly and thereby acts as bad advertising for the product and factory image" (*id.*; emphasis added). In other words, Itkonen is directed to "mill branding" (see, e.g., Published U.S. Application No. 2002-0004732 ¶ [0018]), and thus one would not be motivated to combine Ryan with Itkonen. Moreover, Itkonen's teaches away from Giacomozzi because, while Itkonen is directed to mill branding, Giacomozzi is directed to wrappers having advertisements that are not linked to the wrapped product (Giacomozzi p. 1).

For at least these reasons, appellant submits that claims 57-59 are patentable over the combination of Ryan, Giacomozzi, and Itkonen. Accordingly, appellant requests that the rejection of claims 57-59 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Itkonen be reversed.

5. The rejection of claims 10, 33, 41, 55, and 64 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Crossman is improper

a. Claim 10

Claim 10 depends from claim 1. Thus, for at least the same reasons discussed above in Section VII(B)(3)(a), appellant requests that the rejection of claim 10 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Crossman be reversed.

b. Claim 33

Claim 33 depends from claim 31. Thus, for at least the same reasons discussed above in Section VII(B)(3)(f), appellant requests that the rejection of claim 33 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Crossman be reversed.

c. Claim 41

Claim 41 depends from claim 34. Thus, for at least the same reasons discussed above in Section VII(B)(3)(g), appellant requests that the rejection of claim 41 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Crossman be reversed.

d. Claim 55

Claim 55 depends from claim 52. Thus, for at least the same reasons discussed above in Section VII(B)(3)(i), appellant requests that the rejection of claim 55 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Crossman be reversed.

e. Claim 64

Claim 64 depends from claim 61. Thus, for at least the same reasons discussed above in Section VII(B)(3)(j), appellant requests that the rejection of claim 64 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Crossman be reversed.

f. There is no reason to combine Ryan, Giacomozzi, and Crossman and Ryan, Giacomozzi and Crossman teach away from their combination

Appellant respectfully submits that the Examiner has not identified a sufficient reason for combining Ryan, Giacomozzi, and Crossman. As discussed above in Section VII(B)(1), to present a prima facie case of obviousness, the Examiner must show that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue" (*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, at 1740-41 (2007)). The Examiner's analysis "should be made explicit" (*id.*). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*id. citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The Examiner asserts the following as the reason to combine Ryan, Giacomozzi, and Crossman:

It would have been obvious to...know that Ryan would include third party advertisers coupons into a package wrappers, as taught by Crossman in order to offset the cost of producing said products by billing advertisers for said including, as taught by Ryan.

(Office Action, December 3, 2008, p. 10; emphasis added). Appellant submits that the Examiner has not provided a sufficient reason to combine Ryan, Giacomozzi, and Crossman. Ryan already includes placing third-party advertisements on envelopes as a way of offsetting the cost of producing mailpieces by billing advertisers (see, e.g., Ryan

2:42-45). So Ryan already has the advantage the absence of which the Examiner suggests would motivate one to combine Ryan, Giacomozi, and Crossman. Thus, one would have no reason to combine Ryan and Crossman to achieve this advantage.

Moreover, appellant submits that Ryan, Giacomozi, and Crossman teach away from their combination. Ryan is directed to printing third-party advertisements on envelopes (Ryan 11:43-46). Giacomozi is directed to printing advertisements on a handkerchief wrapper (Giacomozi p. 1). In contrast, Crossman is directed to packaging having a detachable coupon compartment (Crossman 1:5-9). For example, Crossman makes clear that "[w]hen the coupon compartment is detached, the packaging is still functional" (*id.*). Moreover, Crossman discredits techniques, like Ryan's, which print the promotional message directly onto the packaging, because, according to Crossman, "[c]oupons printed directly onto packaging...are not easily removed and if they are removed, the packaging is damaged" (*id.* 1:10-22). Thus, appellant submits that it is improper to combine Ryan, Giacomozi, and Crossman because they teach away from their combination.

For at least these reasons, appellant submits that claims 10, 33, 41, 55, and 64 are patentable over the combination of Ryan, Giacomozi, and Crossman. Accordingly, appellant requests that the rejection of claims 10, 33, 41, 55, and 64 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozi, and Crossman be reversed.

6. The rejection of claims 12-13, 15, 17, 19, and 50 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozi, and Loeb is improper

a. Claims 12-13, 15, and 17

Claims 12-13, 15, and 17 depend from claim 11. Thus, for at least the same reasons discussed above in Section VII(B)(3)(b), appellant requests that the rejection of

claims 12-13, 15, and 17 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb be reversed.

Moreover, appellant submits that the Examiner has failed to establish a prima facie case of obviousness of dependent claim 17. Although the Examiner acknowledges that "Ryan fails to teach...tracking receipt of remuneration from the paper purchaser to an intermediate party for the paper product" as recited by claim 17, the Examiner contends that Loeb cures this deficiency. In particular, the Examiner states:

As per claims 12, 13, 15, 17, 19 and 50 . . .Loeb teaches that 60% of all new subscriptions are acquired by third-party service providers (see column 2, lines 10-20). Therefore, it would have been obvious to a person of ordinary skill in the art the time the application was made, to know that Ryan would use intermediary parties (i.e., agents) that would work to bring more customer to order paper products. The intermediary party would be more than willing to serve as an intermediary in the interaction between paper purchasers and advertisers because said intermediary party would receive remuneration from said interaction.

(Office Action, December 3, 2008, p. 11). Appellant submits that the Examiner's characterization of Loeb does not make reference to the language recited by claim 17, nor does it identify where Loeb discloses tracking receipt of remuneration. Because the Examiner did not indicate how this feature is disclosed or suggested by the references, appellant submits that the Examiner has failed to establish a prima facie case of obviousness of claim 17. Accordingly, appellant requests that the rejection of claim 17 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb be reversed.

b. Claim 19

Claim 19 depends from claim 18. Thus, for at least the same reasons discussed above in Section VII(B)(3)(c), appellant requests that the rejection of claim 19 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb be reversed.

Moreover, appellant submits that the Examiner has failed to establish a prima facie case of obviousness of dependent claim 19. In rejecting claim 19 the Examiner states:

As per claims 12, 13, 15, 17, 19 and 50, Ryan fails to teach: wherein receiving a paper product order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the paper purchaser or a third-party advertiser and tracking receipt of remuneration from the third party advertiser to an intermediate party for the promotional material. However, Loeb teaches that 60% of all new subscriptions are acquired by third-party service providers (see column 2, lines 10-20). Therefore, it would have been obvious to a person of ordinary skill in the art the time the application was made, to know that Ryan would use intermediary parties (i.e., agents) that would work to bring more customer to order paper products. The intermediary party would be more than willing to serve as an intermediary in the interaction between paper purchasers and advertisers because said intermediary party would receive remuneration from said interaction.

(Office Action, December 3, 2008, p. 11). Claim 19 recites "instruct[ing] an intermediate party to place the advertisement on the wrapper." Because the Examiner did not indicate how this feature is disclosed or suggested by the references, appellant submits that the Examiner has failed to establish a prima facie case of obviousness of claim 19. Accordingly, appellant requests that the rejection of claim 19 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb be reversed.

c. Claim 50

Claim 50 depends from claim 49. Thus, for at least the same reasons discussed above in Section VII(B)(3)(h), appellant requests that the rejection of claim 50 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb be reversed.

Moreover, appellant submits that the Examiner has failed to establish a prima facie case of obviousness of dependent claim 50. In rejecting claim 19 the Examiner states:

As per claims 12, 13, 15, 17, 19 and 50, Ryan fails to teach: wherein receiving a paper product order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the paper purchaser or a third-party advertiser and tracking receipt of remuneration from the third party advertiser to an intermediate party for the promotional material. However, Loeb teaches that 60% of all new subscriptions are acquired by third-party service providers (see column 2, lines 10-20). Therefore, it would have been obvious to a person of ordinary skill in the art the time the application was made, to know that Ryan would use intermediary parties (i.e., agents) that would work to bring more customer to order paper products. The intermediary party would be more than willing to serve as an intermediary in the interaction between paper purchasers and advertisers because said intermediary party would receive remuneration from said interaction.

(Office Action, December 3, 2008, p. 11). Claim 50 recites "instruct[ing] an intermediate party to place the advertisement on the wrapper." Because the Examiner did not indicate how this feature is disclosed or suggested by the references, appellant submits that the Examiner has failed to establish a prima facie case of obviousness of claim 50. Accordingly, appellant requests that the rejection of claim 50 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb be reversed.

- d. Ryan, Giacomozzi and Crossman teach away from their combination, at least because one skilled in the art would have no reasonable expectation of success

The Examiner suggests the following as the reason to combine Ryan, Giacomozzi, and Loeb:

It would have been obvious ... to know that Ryan would use intermediary parties (i.e., agents) that would bring more customer to order paper products. The intermediary party would be more than willing to serve as an intermediary in the interaction between the paper purchasers and advertisers because said intermediary party would receive remuneration from said interaction.

(Office Action, December 3, 2008, p. 11; emphasis added.) However, appellant submits that one skilled in the art would have no reasonable expectation of success combining Ryan, Giacomozzi, and Loeb, because a technique for doing so would entail complexities that would require detailed explanation for one of ordinary skill in the art to

implement, which is not present in either Ryan, Giacomozzi, or Loeb. For example, Loeb only comments on the use of agents in the context of selling magazine subscriptions to consumers (Loeb 2:9-18)<sup>4</sup>, while Ryan explains that every user and advertiser of Ryan's production mail system establishes a profile with the system, and it is through these profiles that users and advertisers submit orders (Ryan 8:26-9:45, 11:23-30). Thus, it is unclear how one of ordinary skill in the art would integrate Loeb's agents with Ryan's production mail system to produce the claimed invention.

For at least this reason, appellant submits that claims 12-13, 15, 17, 19, and 50 are patentable over Ryan, Giacomozzi, and Loeb. Accordingly, appellant requests that the rejection of claims 12-13, 15, 17, 19, and 50 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb be reversed.

7. The rejection of claim 60 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, Itkonen, and Crossman is improper

Claim 60 depends from claim 57. Thus, for at least the same reasons discussed above in Section VII(B)(4)(c), appellant requests that the rejection of claim 60 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, Itkonen, and Crossman be reversed.

8. Previously-filed Declaration of Commercial Success Evidences Non-Obviousness of Claimed Invention

Appellant filed a Declaration of Commercial Success ("Declaration") on November 28, 2005. In a subsequent Office Action, the Examiner asserted, the Declaration was not persuasive (Office Action, February 28, 2006, p. 9). Specifically, the Examiner stated, "Applicant's Exhibit B shows gross sales figures, however, the

---

<sup>4</sup> Moreover, Loeb makes clear that "the superior economic model" enjoyed by agents selling consumer magazine subscriptions has no parallel in trade publications. Therefore, it is unclear (and Loeb does not explain) how such a model would be employed outside of selling consumer magazine subscriptions.

Applicant did not give any evidence of company market share or what sales would normally be expected in the market" (*id.* p. 11). The Manual of Patent Examining Procedure § 716.03(b) provides that "[g]ross sales figures do not show commercial success absent evidence as to market share (*Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015 (Fed. Cir. 1985)), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market (*Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988)) (MPEP § 716.03(b); emphasis added). Thus, the MPEP requires evidence as to either (a) market share, (b) the time period during which the product was sold, or (c) what sales would normally be expected in the market. Although the Declaration did not include information as to market share, the Declaration included (a) information as to the time period during which the product was sold (e.g., paragraph 4 states that the product was sold between July 17, 2005 and September 25, 2005), and (b) information as to what sales would normally be expected in the market (e.g., paragraph 4 states that before the claimed invention was sold, the average number of cartons shipped each week was 1,933). Appellant submits that because the Declaration complies with the requirements of the MPEP, the gross sales figures are evidence of commercial success.

The Examiner further remarked that (a) on several high volume weeks "prior to Applicant's claimed invention, the average number of cartons shipped to Costco was higher than the average number of cartons shipped to Costco" during several low volume weeks after introduction of the invention, and (b) "there were whole months previous 7/15/05 that more cartons were shipped to Costco than cartons shipped after 7/17/05" (Office Action, February 28, 2006, pp. 11-12). Appellant notes that the sale of cartons of paper vary on a weekly and monthly basis due to numerous factors. Therefore, picking and choosing weeks with a high sales volume before introduction of the invention and weeks with a low sales volume after introduction of the invention does not accurately illustrate the effect of the invention on sales. Because of the inherent variability in sales over short periods of time, a more accurate depiction of a trend in

sales includes examining averages. When viewed under this standard, the presented sales data shows greater average sales after the claimed invention was introduced.

Moreover, even after manipulating the data in a manner disfavorable to the appellant, the Examiner concedes that the claimed invention resulted in a **28% increase in sales**. A 28% increase in sales—particularly in the sale of a commodity such as paper products—is sufficient to warrant a finding of commercial success and supports a conclusion of non-obviousness. Accordingly, appellant submits that the Declaration shows a nexus between commercial success and the claimed invention, and requests that the rejections of claims 1-47 and 49-67 under 35 U.S.C. § 103(a) over the combinations of Ryan, Giacomozzi, Itkonen, Crossman, and Loeb be reversed.

### VIII. CONCLUSION

Each of claims 1-47 and 49-67 has been improperly rejected, in that (a) the Examiner has failed to provide prior art references that disclose all of the elements of these claims, and (b) the cited references do not support any proper rejection of these claims. Accordingly, appellant seeks the reversal of the rejection of claims 1-7, 9, 11, 14, 16, 18, 20-32, 34-40, 42, 44-47, 49-54, 56, 61-63, and 65-67 under 35 U.S.C. § 103(a) over the combination of Ryan and Giacomozzi; reversal of the rejection of claims 8, 43, and 57-59 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Itkonen; reversal of the rejection of claims 10, 33, 41, 55, and 64 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Crossman; reversal of the rejection of claims 12-13, 15, 17, 19, and 50 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, and Loeb; and reversal of the rejection of claim 60 under 35 U.S.C. § 103(a) over the combination of Ryan, Giacomozzi, Itkonen, and Crossman.

IX. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Appellant on July 31, 2009.

Dated: 8/3/09

Respectfully submitted,

By 

Judy M. Kadoura

Registration No.: 59,883

PERKINS COIE LLP

P.O. Box 1247

Seattle, Washington 98111-1247

(206) 359-8000

(206) 359-7198 (Fax)

Attorney for Applicant

APPENDIX A**Claims Involved in the Appeal of Application Serial No. 09/849,504**

1. A computer system for processing a paper product, comprising:  
a processor and a memory including instructions together providing,
  - a product order tracker configured to receive a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer, the paper product including a roll of paper or a plurality of unbound, stacked paper sheets;
  - a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time; and
  - a paper product tracker configured to provide instructions for creating the enclosure for the paper product, the enclosure having the promotional material of the received promotional material order, the paper product tracker further being configured to provide instructions to enclose the paper product of the received order with the created enclosure, wherein the paper manufacturer, the paper purchaser, and the third-party advertiser are different entities and the third-party advertiser pays to have the promotional material placed on the enclosure of the paper product.

2. The computer system of claim 1, further comprising a remuneration tracker configured to track remuneration paid by the third-party advertiser for the promotional material.

3. The computer system of claim 1, further comprising an artwork tracker configured to provide instructions for creating a fixed medium that includes the promotional material.

4. The computer system of claim 1 wherein the promotions order tracker is configured to coordinate enclosing the paper product with a particular enclosure based on the content of the promotional material, the identity of the paper purchaser, and/or a location to which the paper product is to be delivered.

5. The computer system of claim 1 wherein the promotional material order is a first promotional material order for first promotional material and the third-party advertiser is a first third-party advertiser, and wherein the promotions order tracker is configured to receive a second promotional material order from a second third-party advertiser to place second promotional material on the enclosure.

6. The computer system of claim 1 wherein the product order tracker is configured to receive a paper product order for unbound, stacked sheets of paper and/or a roll of paper.

7. The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper configured to enclose unbound stacked sheets of paper.

8. The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper configured to enclose a roll of paper.

9. The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for an advertisement placed on a box configured to enclose the paper product.

10. The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for a coupon placed on the enclosure.

11. A method in a computer system for preparing a paper product, the method comprising:

receiving a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer;

receiving a promotions order from a third-party advertiser to place promotional material on an enclosure of a paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time;

providing instructions to create an enclosure for the paper product, the enclosure having the promotional material of the received promotions order, and providing instructions to enclose the paper product of the received order with the created enclosure; and

providing instructions to deliver the paper product enclosed with the created enclosure to a delivery location, wherein the paper manufacturer, the paper purchaser, and the third-party advertiser are different entities and

the third-party advertiser pays to have the promotional material placed on the enclosure of the paper product,  
wherein computer-executable instructions implementing the method are stored in memory of the computer system for execution by a processor of the computer system.

12. The method of claim 11 wherein receiving a paper product order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the paper purchaser.

13. The method of claim 11 wherein receiving a promotions order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the third-party advertiser.

14. The method of claim 11, further comprising tracking receipt of remuneration from the third-party advertiser for the promotional material.

15. The method of claim 11, further comprising tracking receipt of remuneration from the third-party advertiser to an intermediate party for the promotional material.

16. The method of claim 11, further comprising tracking receipt of remuneration from the paper purchaser for the paper product.

17. The method of claim 11, further comprising tracking receipt of remuneration from the paper purchaser to an intermediate party for the paper product.

18. A computer system for tracking a transaction among a paper manufacturer, a paper purchaser, and a third-party advertiser, the computer system comprising:

a processor and a memory together providing,

a paper order tracker configured to track an order from the paper purchaser for purchase of a plurality of unbound, stacked paper sheets produced by the paper manufacturer;

an advertisement order tracker configured to track an order from the third-party advertiser for an advertisement placed on a wrapper configured to at least partially enclose and protect the plurality of unbound, stacked paper sheets, wherein the advertisement is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time;

a first remuneration tracker configured to track payment of a first remuneration from the paper purchaser for purchase of the paper; and

a second remuneration tracker configured to track payment of a second remuneration from the third-party advertiser for the advertisement.

19. The computer system of claim 18 wherein the advertisement order tracker is configured to instruct an intermediate party to place the advertisement on the wrapper.

20. The computer system of claim 18 wherein the first remuneration tracker is configured to track the receipt of the first remuneration from the paper purchaser for purchase of the paper.

21. The computer system of claim 18 wherein the second remuneration tracker is configured to track receipt of the second remuneration from the third-party advertiser for the advertisement.

22. A computer system for tracking a transaction among a paper product manufacturer, a paper product purchaser, and a third-party advertiser, the computer system comprising:

a processor and a memory together providing,

an order tracker capable of tracking an order from the third-party advertiser for promotional material placed on an enclosure configured to at least partially enclose and protect a paper product, the paper product including a plurality of unbound, stacked paper sheets produced by the paper product manufacturer or a roll of paper produced by the paper product manufacturer, the enclosure including a wrap or a carton configured to at least partially surround the paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper product purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser, and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time; and

a remuneration tracker capable of tracking remuneration paid by the third-party advertiser for the promotional material and updating a database to indicate receipt of the remuneration.

23. The computer system of claim 22 wherein the remuneration tracker is configured to track remuneration received from the third-party advertiser for the promotional material.

24. The computer system of claim 22 wherein the order tracker is configured to track an order for an advertisement placed on an external surface of a wrapper configured to enclose a ream of paper.

25. The computer system of claim 22 wherein the order tracker is configured to track an order for a coupon disposed on the enclosure.

26. A computer-readable storage medium comprising instructions that, when executed by a processor, cause the processor to perform a method for tracking a transaction among a paper product manufacturer, a paper product purchaser, and a third-party advertiser, the method comprising:

receiving an indication of an order from the third-party advertiser for promotional material placed on an enclosure configured to at least partially enclose and protect a paper product, the paper product including a plurality of unbound, stacked paper sheets produced by the paper product manufacturer, or a roll of paper produced by the paper product manufacturer, the enclosure including a wrap or a carton configured to at least partially surround the paper product, wherein the promotional material is specifically targeted to a group of people associated with the paper product purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser;

updating a database to indicate receipt of the order;

receiving an indication that remuneration has been paid by the third-party advertiser for the promotional material; and

updating the database to indicate payment of the remuneration.

27. The computer-readable storage medium of claim 26 wherein the method further comprises:

receiving an indication that remuneration has been received from the third-party advertiser for the promotional material; and  
updating the database to indicate receipt of the remuneration.

28. The computer-readable storage medium of claim 26 wherein receiving an indication of an order includes receiving an indication of an order for an advertisement disposed on an external surface of a ream wrapper.

29. The computer-readable storage medium of claim 26 wherein the method further comprises providing instructions to create an enclosure for the paper product, the enclosure having the promotional material of the received promotions order, and providing instructions to enclose the paper product of the received order with the created enclosure.

30. The computer-readable storage medium of claim 26 wherein the method further comprises providing instructions to deliver the paper product enclosed with the created enclosure to a delivery location.

31. A method for selling paper products over a computer network, comprising:  
receiving an order for a paper product from a purchaser over a computer network, the paper product including unbound stacked sheets of paper or a roll of paper; and

filling the order with a paper product manufactured by a paper product manufacturer, the paper product being at least partially enclosed by a protective enclosure, the enclosure having promotional material configured to identify and/or promote goods and/or services of a third party different from the manufacturer and different from the purchaser,

wherein an identity of the purchaser is withheld from the paper product manufacturer and an identity of the paper product manufacturer is withheld from the purchaser, wherein the promotional material is specifically targeted to a group of people associated with the purchaser, the group comprising those people likely to purchase the goods or services of the third-party.

32. The method of claim 31 wherein filling the order includes providing a ream of paper wrapped with a ream wrap having an advertisement promoting goods and/or services of the third party.

33. The method of claim 31 wherein filling the order includes providing a coupon disposed on the enclosure.

34. A method in computer systems for providing paper products with promotional materials, comprising:

receiving an order from a purchaser for a paper product, the paper product including unbound stacked sheets of paper or a roll of paper;

providing instructions for manufacturing the paper product;

providing instructions for disposing promotional material on an enclosure configured to at least partially enclose and protect the paper product, the promotional material being requested by a third-party advertiser different than the purchaser, wherein the promotional material is specifically targeted to a group of people associated with the purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser; and

providing instructions for disposing the paper product within the enclosure,

wherein computer-executable instructions implementing the method are stored in memory of the computer systems for execution by one or more processors of the computer systems.

35. The method of claim 34, further comprising receiving a remuneration from the purchaser.

36. The method of claim 34, further comprising receiving a remuneration from the third-party advertiser.

37. The method of claim 34, further comprising disposing the promotional material on the enclosure before disposing the paper product within the enclosure.

38. The method of claim 34, further comprising disposing the promotional material on the enclosure after disposing the paper product within the enclosure.

39. The method of claim 34, further comprising receiving an order from the third-party advertiser for the promotional material.

40. The method of claim 34 wherein providing instructions for disposing promotional material comprises providing instructions for printing an advertisement on an external surface of the enclosure.

41. The method of claim 34 wherein providing instructions for disposing promotional material comprises providing instructions for providing coupons disposed on the enclosure.

42. The method of claim 34 wherein providing instructions for disposing promotional material on an enclosure comprises providing instructions for disposing promotional material on a ream wrap configured to enclose a ream of paper.

43. The method of claim 34 wherein providing instructions for disposing promotional material on an enclosure comprises providing instructions for disposing promotional material on a roll wrap configured to enclose a roll of paper.

44. The method of claim 34 wherein providing instructions for disposing promotional material on an enclosure comprises providing instructions for disposing promotional material on a skid wrap configured to enclose a stack of unbound paper on a skid.

45. The method of claim 34 wherein providing instructions for disposing promotional material on an enclosure comprises providing instructions for disposing promotional material on a carton configured to contain the paper product.

46. The method of claim 34, further comprising disbursing a remuneration from the purchase.

47. The method of claim 34, further comprising disbursing a remuneration from the third-party advertiser for the promotional material.

48. (Cancelled)

49. A method for providing paper products with promotional materials, comprising:

receiving an order from a purchaser for a ream of paper;

receiving an order from a third-party advertiser for an advertisement placed on a wrapper configured to at least partially enclose and protect the ream of paper, wherein the promotional material is specifically targeted to a group of people associated with the purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser;

manufacturing the ream of paper;

wrapping the ream of paper with the wrapper, the wrapper having the advertisement and at least partially enclosing and protecting the ream of paper;

receiving a first remuneration from the purchaser for the ream of paper; and

receiving a second remuneration from the third-party advertiser for the advertisement on the wrapper,

wherein computer-executable instructions implementing the receiving of the order from the purchaser and the receiving of the order from the third-party advertiser are stored in memory of a computing system for execution by a processor of the computing system.

50. The method of claim 49, further comprising instructing an intermediate party to place the advertisement on the wrapper.

51. The method of claim 49, further comprising selecting the wrapper for the ream based on the content of the advertisement, the identity of the purchaser, and/or a location to which the ream is to be delivered.

52. A package of paper products, comprising:

a plurality of stacked, unbound paper sheets produced by a paper sheet manufacturer and purchased by a paper purchaser;

a wrapper disposed around the plurality of paper sheets, the wrapper being positioned to at least partially enclose and protect the plurality of paper sheets; and

promotional material disposed on the wrapper, the promotional material having a content configured to identify and/or promote goods and/or services of a paying third-party advertiser different from the manufacturer and different from the paper purchaser, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser.

53. The package of claim 52 wherein the promotional material includes an advertisement.

54. The package of claim 52 wherein the third-party advertiser is a first third-party advertiser and the promotional material includes a first advertisement configured to identify and/or promote goods and/or services of the first third-party advertiser, and wherein the promotional material further includes a second advertisement configured to identify and/or promote goods and/or services of a second third-party advertiser.

55. The package of claim 52 wherein the promotional material includes a coupon.

56. The package of claim 52 wherein the plurality of stacked, unbound paper sheets includes a ream of paper.

57. A packaged roll of paper, comprising:  
an elongated sheet of paper rolled upon itself to form a paper roll, the elongated sheet of paper being produced by a paper sheet manufacturer and purchased by a paper purchaser;  
a wrapper disposed around the paper roll, the wrapper being positioned to at least partially enclose and protect the paper roll; and  
promotional material disposed on the wrapper, the promotional material having a content configured to identify and/or promote goods and/or services of a paying third-party advertiser different from the manufacturer and different from the paper purchaser, wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third-party advertiser.

58. The packaged roll of claim 57 wherein the promotional material includes an advertisement.

59. The packaged roll of claim 57 wherein the third-party advertiser is a first third-party advertiser and the promotional material includes a first advertisement configured to identify and/or promote goods and/or services of the first third-party advertiser, and wherein the promotional material further includes a second advertisement configured to identify and/or promote goods and/or services of a second third-party advertiser.

60. The packaged roll of claim 57 wherein the promotional material includes a coupon.

61. A package of paper products, comprising:  
a plurality of unbound paper sheets produced by a paper sheet manufacturer  
and purchased by a paper purchaser;  
a carton in which the plurality of paper sheets is positioned, the carton at least  
partially enclosing and protecting the paper sheets; and  
promotional material disposed on the carton, the promotional material having a  
content configured to identify and/or promote goods and/or services of a  
paying third-party advertiser different from the paper sheet manufacturer  
and the paper purchaser, wherein the promotional material is specifically  
targeted to a group of people associated with the paper purchaser, the  
group comprising those people likely to purchase the goods or services of  
the third-party advertiser, and wherein the group of people are likely to  
view the promotional material on the enclosure for an extended period of  
time.

62. The package of claim 61 wherein the promotional material includes an  
advertisement.

63. The package of claim 61 wherein the third-party advertiser is a first third-  
party advertiser and the promotional material includes a first advertisement configured  
to identify and/or promote goods and/or services of the first third-party advertiser, and  
wherein the promotional material further includes a second advertisement configured to  
identify and/or promote goods and/or services of a second third-party advertiser.

64. The package of claim 61 wherein the promotional material includes a  
coupon.

65. The method of claim 34, further comprising instructing another entity to  
dispose the promotional material on the enclosure.

66. The computer system of claim 1 wherein the product order tracker is configured to receive a paper product order for unbound, stacked, unfolded sheets of paper.

67. The computer system of claim 1 wherein the paper purchaser is an office, and the group of people are employees that work in the office.

**APPENDIX B**

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

**APPENDIX C**

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.